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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,266	01/14/2004	George Koutlakis	030901	4897

26285 7590 06/20/2005

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PITTSBURGH, PA 15222

EXAMINER
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MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/757,266

Applicant(s)

KOUTLAKIS ET AL

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.  
4a) Of the above claim(s) 1-14 and 33-46 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 15-32 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15-32 are rejected under 35 U.S.C. 103(a) as obvious over Koutlakis et al. (257) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 15, 17, 18, 20, 22, 24, 26 and 28-32 are rejected under 35 U.S.C. 103(a) as obvious over Lane et al. (068) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Applicant's arguments filed 4/21/05 have been fully considered but they are not persuasive.

Applicants argue that crushing or grinding is not necessary to practice the invention. This is not persuasive because (1) the claims define "processing the solid materials" and this broadly encompasses "crushing or grinding" and (2) the claims do not exclude this step. Applicants argue that this references fail to disclose the claimed size. The examiner is aware that the exact size is not literally disclosed, but the examiner stated in the last office action that the desired particle size is a function of the application and mere recitation of that size does not represent a patentable distinction over the references to one of ordinary skill in the art, lacking evidence to the contrary. In view of the above, one skilled in the art would have found the claimed size obvious depending on the application. Applicants have not persuasively argued this point. As is previously defined, the independent claims of the references do not define a size, thus the broad

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interpretation of the claims is that the polysaccharide can have a broad size and is not limited to the specific size in the specification. **Since a reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421, it is the examiners position that claim 1 of the reference realistically teaches polysaccharide grits that are not limited in size.** If the reference claim only intended to make polysaccharide grits of the size defined in the specification, **the claim would have recited said size**. The size would have been obvious depending on the application required. To support the examiners position that the size would have been obvious depending on its application, the examiner refers applicants to Hirano et al. which clearly discloses, in the abstract, that blasting media is known to have a size of 10 mm. The examiner acknowledges that the blasting media is not polysaccharide but this reference has only been cited to clearly support the examiners position in the last office action that the size is obvious depending on its application. Why are the independent claims of the references limited to only the sizes defined in the specification, as suggested by applicants?

In the abstract and in column 5, lines 50-51 of Koutlakis et al., it is stated that the invention is based on **abrasive grits** and that the solid material can be ground to an **appropriate size**. The broad interpretation of this is that the solid material can be ground to an appropriate size **depending on its application**. Following this statement is the criteria that the abrasive grit is used as blasting media. This criteria can be considered a preferred embodiment and if the reference was only limited to blasting media, why **doesn't** claim 1 define a method for producing blasting media? To the contrary, the claim defines a method for producing abrasive grit and the

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interpretation of abrasive grit is much broader than a blasting media (i.e. abrasive media can encompass a tumbling media).

In the abstract and in column 13, lines 7-8 of Lane et al., it is stated that the invention is based on **abrasive grits** for treating surfaces and that the solid material are useful in abrasive grit applications. The broad interpretation of this is that the solid material is used in any abrasive application and thus grinding to an appropriate size **depending on its application** is within the scope of the reference. Following this statement is the criteria that the abrasive grit is used as blasting media. This criteria can be considered a preferred embodiment and if the reference was only limited to blasting media, why **doesn't** claim 1 define a method for producing blasting media? To the contrary, the claim defines a method for producing abrasive grit and the interpretation of abrasive grit is much broader than a blasting media (i.e. abrasive media can encompass a tumbling media). In addition, in column 4, lines 6-10 it is stated that the grit is used for abrasive application and defines a particular **example** which is directed to projecting the grit against a surface (blasting). An example of the application is not a limiting factor for the reference, as a whole.

As a further point and assuming further arguendo, **both** the claimed invention and the references use the term "about" to define the size and since "about" **permits some tolerance**, *In re Ayers*, 154 F.2d 182, 69 USPQ 109, the claimed size can deviate from 6 mm and the references can deviate from 12 U.S. Mesh, thus, when taken as a whole in that both the references and the claimed invention modify the size with the limitation "about", the limitation "about 6 mm" reads on "about 12 U.S. Mesh (mm size)".

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Applicants also appear to argue that the claimed size is particularly useful for grinding polishing and drying compositions that use mechanical agitation. This argument appears to be based on the showing of criticality for the claimed size. This is not persuasive because the claims are only directed to a process and do not recite any of the claimed uses. Even if the uses were defined, the intended use provide no weight to the claimed process. How can criticality be shown for limitations that are not part of the claim (i.e. the uses)? In addition, the examples defined by applicants all contain a size range that is not within the range claimed. In summary, applicants have not clearly shown any evidence of criticality for the claimed sizes.

Applicants assert that the cited references do not disclose the claimed range and state that the examiner has not indicated how such a size could be reasonably inferred from the references. As defined above, the size would have been obvious depending on the application required and applicants have not argued this (i.e. that the desired particle size is a function of the application). Why are the references only limited to the sizes defined and why doesn't the desired application of an abrasive grit (reference are not limited to blasting grit as defined above) suggest broad sizes.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**This action can be made final because the rejections are still the same and although the examiners arguments refer to Hirano et al., this reference is only used to support the examiners position taken in the last office action (i.e. the size would have been obvious depending on its application). In summary, the basis for the rejection has not changed.**

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548.

Evidence of unexpected results must be commensurate in scope with the subject matter claimed.

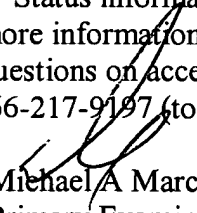
*In re Linder* 173 USPQ 356.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/05  
MM

  
Michael A Marcheschi  
Primary Examiner  
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